

**Notice of Allowability**

Application No.

09/196,136

Examiner

Guy J. Lamarre

Applicant(s)

OHBAYASHI, SHIGEKI

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**-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address--**

All claims being allowable, PROSECUTION ON THE MERITS IS (OR REMAINS) CLOSED in this application. If not included herewith (or previously mailed), a Notice of Allowance (PTOL-85) or other appropriate communication will be mailed in due course. **THIS NOTICE OF ALLOWABILITY IS NOT A GRANT OF PATENT RIGHTS.** This application is subject to withdrawal from issue at the initiative of the Office or upon petition by the applicant. See 37 CFR 1.313 and MPEP 1308.

1. ☒ This communication is responsive to 8/20/04 and 2/2/05.
2. ☒ The allowed claim(s) is/are 1-11.
3. ☒ The drawings filed on 20 November 1998 are accepted by the Examiner.
4. ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
  - a) ☒ All    b) ☐ Some\*    c) ☐ None    of the:
    1. ☒ Certified copies of the priority documents have been received.
    2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
    3. ☐ Copies of the certified copies of the priority documents have been received in this national stage application from the International Bureau (PCT Rule 17.2(a)).
- \* Certified copies not received: \_\_\_\_\_.
5. ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
  - (a) ☐ The translation of the foreign language provisional application has been received.
6. ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Applicant has THREE MONTHS FROM THE "MAILING DATE" of this communication to file a reply complying with the requirements noted below. Failure to timely comply will result in ABANDONMENT of this application. **THIS THREE-MONTH PERIOD IS NOT EXTENDABLE.**

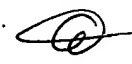
7. ☐ A SUBSTITUTE OATH OR DECLARATION must be submitted. Note the attached EXAMINER'S AMENDMENT or NOTICE OF INFORMAL PATENT APPLICATION (PTO-152) which gives reason(s) why the oath or declaration is deficient.
8. ☐ CORRECTED DRAWINGS must be submitted.
  - (a) ☐ including changes required by the Notice of Draftsperson's Patent Drawing Review (PTO-948) attached
    - 1) ☐ hereto or 2) ☐ to Paper No. \_\_\_\_\_.
  - (b) ☐ including changes required by the proposed drawing correction filed \_\_\_\_\_, which has been approved by the Examiner.
  - (c) ☐ including changes required by the attached Examiner's Amendment / Comment or in the Office action of Paper No. \_\_\_\_\_.

Identifying indicia such as the application number (see 37 CFR 1.84(c)) should be written on the drawings in the top margin (not the back) of each sheet. The drawings should be filed as a separate paper with a transmittal letter addressed to the Official Draftsperson.

9. ☐ DEPOSIT OF and/or INFORMATION about the deposit of BIOLOGICAL MATERIAL must be submitted. Note the attached Examiner's comment regarding REQUIREMENT FOR THE DEPOSIT OF BIOLOGICAL MATERIAL.

**Attachment(s)**

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|--|---|
| 1 <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)                             | 2 <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)          |
| 3 <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                    | 4 <input checked="" type="checkbox"/> Interview Summary (PTO-413), Paper No. _____. |
| 5 <input type="checkbox"/> Information Disclosure Statements (PTO-1449), Paper No. _____.              | 6 <input checked="" type="checkbox"/> Examiner's Amendment/Comment                  |
| 7 <input type="checkbox"/> Examiner's Comment Regarding Requirement for Deposit of Biological Material | 8 <input checked="" type="checkbox"/> Examiner's Statement of Reasons for Allowance |
|  | 9 <input type="checkbox"/> Other  |

  
Guy J. Lamarre, P.E.  
Primary Examiner  
5/1/2005

### **Examiner's Amendment & Reasons for Allowance**

. This office action is in response to Applicants' amendment of *8/20/2004* and Applicants' election of Claims 1-11 and withdrawal of Claims 12-18 filed 2/2/2005.

. **Claims 1, 12, 14-15** are amended. **Claims 12-18** are withdrawn from consideration. **Claims 1-11** remain pending.

. The rejections and objections of record are withdrawn in response to Applicants' amendment.

### **Examiner's Amendment**

. An examiner's amendment to the record appears below. Should the changes and/or additions be unacceptable to applicant, an amendment may be filed as provided by 37 CFR 1.312. To ensure consideration of such an amendment, it **MUST** be submitted no later than the payment of the issue fee.

Authorization for this examiner's amendment was given in a telephone interview with Brian Seidleck on 2 May 2005.

The following has been amended:

- 1) Withdrawn **Claims 12-18** are cancelled without prejudice.

### **Response to Arguments**

. Applicants' arguments of *8/20/2004* have been fully considered, and are found persuasive. As a result, **Claims 1-11** are allowed as follows.

### **Reasons for Allowance**

. **Claims 1-11** are allowable over the prior art.

. The following is an examiner's statement of reasons for allowance:

The prior art of record is as exemplified by **Ohashi** (US Patent No. 6,107,874; 23 Jan. 1998), **Ruparel et al.** (A vertically integrated test methodology based on JTAG IEEE 1149.1

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Standard Interface; IEEE, 27 Sept. 1991) and Iketani et al. (US Patent No. 5,703,510, Feb. 1996).

For example, **Ohashi** teaches pad voltage setting means wherein a 'semiconductor integrated circuit device is responsive to a potential level applied to a signal pad connected to a mode changer, and the mode changer causes a mode selector to change a control signal between a first level indicative of a certain combination of sub-circuits of a main circuit selected before separation of the semiconductor chip from a master slice and a second level indicative of another combination of the sub-circuits not selected by a customer; when the manufacturer evaluates the semiconductor integrated circuit device, the manufacturer changes the potential level at the signal pad, and carries out a test for the certain combination and another combination; when the semiconductor chip is sealed in a package, the signal pad is electrically isolated from a source of potential level, and the control signal is fixed to the first level.'

**However**, prior art references do not teach or suggest alone or in combination semiconductor integrated circuit comprising: boundary scan testing circuit and a pad wherein the pad potential level is set according to a type of a package in which said semiconductor integrated circuit is sealed, as claimed.

. Any comments considered necessary by applicant must be submitted no later than the payment of the issue fee and, to avoid processing delays, should preferably accompany the issue fee. Such submissions should be clearly labeled "Comments on Statement of Reasons for Allowance."

## CONCLUSION

. Any response to this action should be mailed to:

Commissioner of Patents and Trademarks, Washington, D.C. 20231

**or faxed to:** (703) 872-9306 for all formal communications.

Hand-delivered responses should be brought to Customer Services, 220 20<sup>th</sup> Street S., Crystal Plaza II, Lobby, Room 1B03, Arlington, VA 22202.

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Any inquiry concerning this communication or earlier communications from the examiner should be directed to Guy J. Lamarre, P.E., whose telephone number is (571) 272-3826. The examiner can normally be reached on Monday to Friday from 9:30 AM to 6:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Albert De Cady, can be reached at (571) 272-3819.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group receptionist whose telephone number is (571) 272-3609.

Information regarding the status of an application may also be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Guy J. Lamarre, P.E  
Primary Examiner  
5/2/2005

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